

REMARKS

Claims 39 and 42-61 are currently pending in the application. Applicant has amended claim 39 and canceled claim 52. Applicant requests reconsideration of the application in light of the following remarks.

Rejections under 35 U.S.C. §112

Claims 39 and 42-61 stand rejected by the Examiner under 35 U.S.C. 112. In accordance with this rejection, the independent base claim 39 has been amended and all claims are now believed to conform with Section 112. Applicants respectfully request that the rejection of claims 39 and 42-61 under 35 U.S.C. § 112 be withdrawn.

Rejections under 35 U.S.C. §103

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims 39 and 42-61

Claims 39 and 42-61 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Keyes et al. (U.S. Patent No. 6,456,983, hereinafter "Keyes"), in view of Jones

(U.S. Patent No. 6,044,351, hereinafter “Jones”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

The Claims are Not Obvious

The combination of Keyes and Jones referred to by the Examiner fails to provide a *prima facie* showing of obviousness as required by §2143 of the Manual of Patent Examining Procedure (MPEP). Three criteria must be met to provide *prima facie* obviousness. The first of these is a suggestion or motivation in the references or the knowledge generally available to combine the reference teachings. The second is that a reasonable expectation of success must exist from the references should the combination be carried out. The third is that the prior art must teach or suggest all of the claim limitations. Applicants submit that all of these elements are lacking in the Examiner’s rejection.

A. No Motivation or Suggestion to Combine the References

When applying 35 U.S.C. § 103, the references must be considered as a whole and must suggest the desirability and, thus, the obviousness of making the combination. *Hodash v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143, n. 5, 229 USPQ 182, 187, n. 5 (Fed. Cir. 1986).

Applicants further submit that references cannot be considered collectively until the Examiner points to some motivation to combine those references. The purpose behind this requirement is to prevent the Examiner from using the invention itself and hindsight reconstruction to defeat the patentability of the invention. The Federal Circuit, in a recent decision, articulates this position:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

See In re Rouffet et al., No. 97-1492, 1998 U.S. App. Lexis 16414, at 15-16 (Fed. Cir. July 15, 1998).

The references do not teach the desirability of making the combination. Keyes teaches a system and method for evaluating an offer made in relation to certain delinquent accounts, and more specifically to charge accounts. The system has two components, a historical portfolio module and an evaluation module that is operated by a computer. The historical portfolio module is used to retrieve an appropriate collection of historical data based upon analysis to be conducted on certain currently delinquent accounts, identify a basis for dividing the retrieved collection of historical data into a plurality of groups, and obtain information on the payment history for each group. The evaluation module can then process the information from the historical portfolio and make a recommendation on the disposition of the currently delinquent accounts being analyzed. A NPV is calculated and the preferred system calculates three separate NPV's and compares them to determine the disposition of the delinquent accounts, i.e. whether to accept an offer or not. (See col. 4, line 42 - col. 5, line 10 and col. 9, line 39 - col. 10, line 19).

Jones is a computer software program that predicts the probability distribution of health care facility future minimum income for a total time interval consisting of equal sized time subintervals. This information provides physicians with information to be able to compare costs and worst case scenario future income. (See col. 2, lines 9-30).

The Office Action asserts that it would be obvious to combine the evaluation of an offer made in relation to delinquent accounts aspects of the Keyes system with the prediction of the probability distribution of health care facility future minimum income aspects of Jones for the "motivation of allowing a physician to predict future health care income to plan for the 'worst case' scenario." *See* Office Action, p. 4. The Office Action reads far too much into this purported motivation. The asserted motivation does not provide motivation to combine the Keyes system with the future minimum income aspect of Jones, but rather to combine some other system for determining the worst case scenario or income related to costs.

The cited section of Jones, col. 1, lines 10-20 that the Examiner quotes as motivation to combine, relates specifically to “FMI [future minimum income] can be valuable in a medical practice, particularly office and health care delivery planning,” and further explains that “FMI can be viewed as the ‘worst case’ scenario for physician income.” There is no motivation found in Jones to combine the future minimum income system of Jones with a disposition of delinquent accounts system like Keyes because the systems like Keyes operate on the fact that the consumer has already received a service or valued return for the debt incurred and is determining a relative value of each group of currently delinquent accounts with respect to historical variables. Jones operates on the basic presumption insurance companies will pay its debts according to its payment fee schedule. The value of the future minimum income already assumes that the insurance company will make the payment and therefore would not be motivated to combine with a system that operates specifically with delinquent accounts.

B. Cited References do not Provide Reasonable Expectation of Success

The cited references do not provide a reasonable expectation of successful combination or an explanation of how they would be combined to teach or suggest the claimed invention. While the Examiner argues one would be motivated to combine the Keyes disposition of delinquent accounts with the future minimum income of Jones, the Federal Circuit has held that “obvious to experiment” is not the standard for obviousness. *In re Dow Chemical*, 5 USPQ2d 1529 at 1532 (Fed. Cir. 1988). In moving from the prior art to the claimed invention, one cannot base a determination of obviousness on what the skilled person might try or find obvious to try. The proper test requires determining whether the prior art provides an express suggestion to combine with an expectation of success.

The Office Action asserts that the disposition of delinquent accounts should be applied to the prediction of future minimum income process, but does not indicate where in the combined teachings of Keyes and Jones the explanation exists for how to combine the references or that there will be any indication that such a combination will provide a valued service or even be

feasible. In the references, there does not appear to be any indication that the use of historical data of a delinquent account can adequately or successfully be combined with the medical health services field to make a determination by use of historical payment data from an third party payer what the value of a future medical service would be. Additionally, neither Keyes nor Jones disclose what effect, or infer that it may have an effect, late payment, partial payment or non-payment by a third party payer may have on the value of a future medical service to be provided to a patient. Different considerations need to be made in evaluating the likelihood of success for collecting from an insurance company for a future medical service to be provided to a patient according to the insurance company's schedule of fees.

A person skilled in the art would not be led to combine a system for evaluating an offer made in relation to certain delinquent accounts with a system that predicts the probability distribution of health care facility future minimum income to determine specifically the value likely to be collected from the insurance company based upon their historical payments prior to providing the medical service from the disclosures of Keyes and Jones. Again, Applicant only discovered the value and possibilities for its system after significant empirical calculations and experimentation, the ultimate results of which are provided in Applicant's specification. Prior to these experiments and the efforts and ingenuity of Applicant, it was impossible to predict whether such a system was viable and whether the process would be valuable to doctors. Therefore, no reasonable expectation of success existed previously.

C. Cited References Do Not Teach the Claim Limitations

Even if the cited references are combined (and Applicant maintain that combination is improper), the cited references do not teach each claim limitation. The teachings of Keyes and Jones are detailed under section A above. Claim 39 recites, "accesses data indicative of the historical payment patterns of the TPP to one or more medical service providers from which a net present value of a future payment by the TPP for at least one future medical service for a patient associated with the TPP may be generated; . . . generates an indication of the net present value of

the at least one future medical service prior to providing the medical service, the indication based at least in part on the historical payment patterns of the TPP to the one or more medical service providers; and . . . generates an indication of when a patient's appointment should be scheduled."

Claim 39 was amended and includes the limitation of canceled claim 52. Claim 39 recites, "a processor operating in accordance with software, wherein the processor, under software control: . . . generates an indication of when a patient's appointment should be scheduled, depending in part upon the net present value." Keyes and Jones fail to disclose this limitation as indicated by the Examiner in the Office Action referring to claim 52. The Office Action asserts that in further view of Evans, this limitation is disclosed. Evans discloses the ability for a health care provider to schedule an appointment using a point and click interface. However, Evans does not disclose the use of a net present value as a factor in determining when an appointment should be scheduled, nor does the software generate an indication of when an appointment should be scheduled.

One significant problem with the type of system disclosed in Jones, that Applicant's claimed invention attempts to overcome, is that the calculation of future minimum income is based in part upon a belief that the insurance company or payment source will pay for the services provided. The calculation as to what the net present value of the future payment by the TPP for the future medical service is not considered when calculating the future minimum income.

A significant problem with the system disclosed in Keyes is the net present value. While it is true that both the Applicant's claimed invention and the system of Keyes each assign a net present value, they are considerably different. Keyes determines a net present value on a group of accounts that are currently delinquent by considering in part the historical data of the group of similar delinquent accounts. Applicant's claimed invention determines a net present value of a single future account with consideration of a third party payer's payment historical data. There cannot be a delinquent account when no actual account exists and services have not been rendered. A determination as to the net present value of a future medical service is not taught in either reference. Nor is it considered in either reference how long it will take the insurance

company to pay the bill, whether the insurance company will pay the full amount of the bill from the fee schedule, or whether the insurance company will declare bankruptcy before the scheduled amount is paid as part of a determination of a net present value. Applicant's invention of claim 39 addresses the problem faced by doctors who find that many insurance companies, and particularly ones that are in financial difficulty, delay payments for several months and discount fees paid to maximize current profits. Thus, although the current schedule of fees for two different insurance companies may be the same for a particular medical procedure, the present value of the future payment from that insurance company to the doctor may be significantly different. Although the doctors did not consider this when they were agreeing to provide a particular medical service for a particular insured patient, the doctors are stuck with the result under which the Keyes system would then be beneficial. Doctors regularly find that despite the schedule of fees and the presumption that payment will be received, they are struggling to cover their office expenses due to delays in insurance company payments, which is not considered in Jones.

Because there is no teaching, suggestion or motivation to combine Keyes with Jones, no reasonable expectation of success if they were combined as the Examiner suggests, and not all of the elements of claim 39 are included within the proposed combination of references, claim 39 is allowable over the combination of Keyes and Jones. Dependent claims 42-61 are each allowable over the combination of Keyes and Jones, among other reasons, for depending from allowable claim 39. Accordingly, Applicant respectfully requests that the obviousness rejection of claims 39 and 42-61 be withdrawn.

Claims 52 and 59-60

Claims 52 and 59-60 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Keyes et al. (U.S. Patent No. 6,456,983, hereinafter "Keyes"), in view of Jones (U.S. Patent No. 6,044,351, hereinafter "Jones"), as applied to claim 39, and further in view of Evans (U.S. Patent No. 5,924,074, hereinafter "Evans"). Claim 52 has been canceled. The

rejection of claim 52 is, therefore, obviated. Applicant respectfully traverses the rejection of claims 59-60 and request reconsideration of the claims.

With reference to claim 39, Applicant has discussed why it is not proper to combine Keyes and Jones, why the combination of those references does not teach or suggest every element of claim 39, and why even if they were combined there is no reasonable expectation of success. Evans does not include any additional disclosure that would change that evaluation, and the most recent Office Action has not asserted any relevant to claim 39. Evans discloses an electronic medical records system with the ability to schedule appointments. Accordingly, dependent claims 59-60 are allowable over the combination of references, among other reasons, for depending from allowable claim 39. Applicant respectfully requests that the obviousness rejection of claims 59-60 be withdrawn.

Claims 54-55

Claims 54-55 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Keyes et al. (U.S. Patent No. 6,456,983, hereinafter “Keyes”), in view of Jones (U.S. Patent No. 6,044,351, hereinafter “Jones”), as applied to claim 39, and further in view of Rensimer et al. (U.S. Patent No. 5,845,253, hereinafter “Rensimer”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

With reference to claim 39, Applicant has discussed why it is not proper to combine Keyes and Jones, why the combination of those references does not teach or suggest every element of claim 39, and why even if they were combined there is no reasonable expectation of success. Rensimer does not include any additional disclosure that would change that evaluation, and the most recent Office Action has not asserted any relevant to claim 39. Rensimer discloses a system for providing a recommended duration for an appointment based upon the service being performed. Rensimer does not disclose anything suggesting that the duration is based in any part upon the payment patterns of the TPP. Accordingly, dependent claims 54 and 55 are allowable over the combination of references on their own and, among other reasons, for depending from

allowable claim 39. Applicant respectfully requests that the obviousness rejection of claims 54 and 55 be withdrawn.

Claims 56-58

Claims 56-58 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Keyes et al. (U.S. Patent No. 6,456,983, hereinafter “Keyes”), in view of Jones (U.S. Patent No. 6,044,351, hereinafter “Jones”), as applied to claim 39, and further in view of Joao (U.S. Patent No. 6,283,761, hereinafter “Joao”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

With reference to claim 39, Applicant has discussed why it is not proper to combine Keyes and Jones, why the combination of those references does not teach or suggest every element of claim 39, and why even if they were combined there is no reasonable expectation of success. Joao does not include any additional disclosure that would change that evaluation, and the most recent Office Action has not asserted any relevant to claim 39. Joao discloses a system for wireless superbill creation. Joao does not disclose anything suggesting that the duration is based in any part upon the payment patterns of the TPP. Accordingly, dependent claim 56-58 is allowable over the combination, among other reasons, for depending from allowable claim 39. Applicant respectfully requests that the obviousness rejection of claims 56-58 be withdrawn.

Applicants respectfully request that the obviousness rejections of claims 39 and 42-61 be withdrawn.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.



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CONCLUSION

In summary, and in view of the amendments herein, none of the references cited by the Examiner nor any other known prior art, either alone or in combination, disclose the unique combination of features disclosed in applicant's claims presently on file. For this reason, allowance of all of applicant's claims is respectfully solicited.

It is requested that a two-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$225.00 is enclosed herewith.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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By

Albert L. Schmeiser

Reg. No. 30,681

SCHMEISER, OLSEN & WATTS LLP

18 East University Drive, #101

Mesa, AZ 85201

(480) 655-0073